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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,717	03/18/2004	Larry Hurst	9H01.1-011	6987
23506	7590	07/29/2005	EXAMINER	
GARDNER GROFF, P.C. 2018 POWERS FERRY ROAD SUITE 800 ATLANTA, GA 30339			LE, TAN	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,717	Applicant(s) HURST, LARRY	
	Examiner Tan Le	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the second office action for application serial number 10/803,717. This application contains 4 claims numbered 1-4. Claim 5 has been canceled.
2. Amendment to specification filed 5/04/05 has been entered.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,619,825 to Leroney et al.

Leroney et al. teaches a clip for attaching a gutter cap (34) to a gutter (12, 16, 18, 20, 22, 24), the clip comprising (see marked-up copy): a front portion having a shape configured to interlock with a front hem edge of the gutter; a back portion having a shape configured to interlock with an edge of the gutter cap; and a support bracket having a shape configured to rest against the gutter to maintain the clip in an installment position.

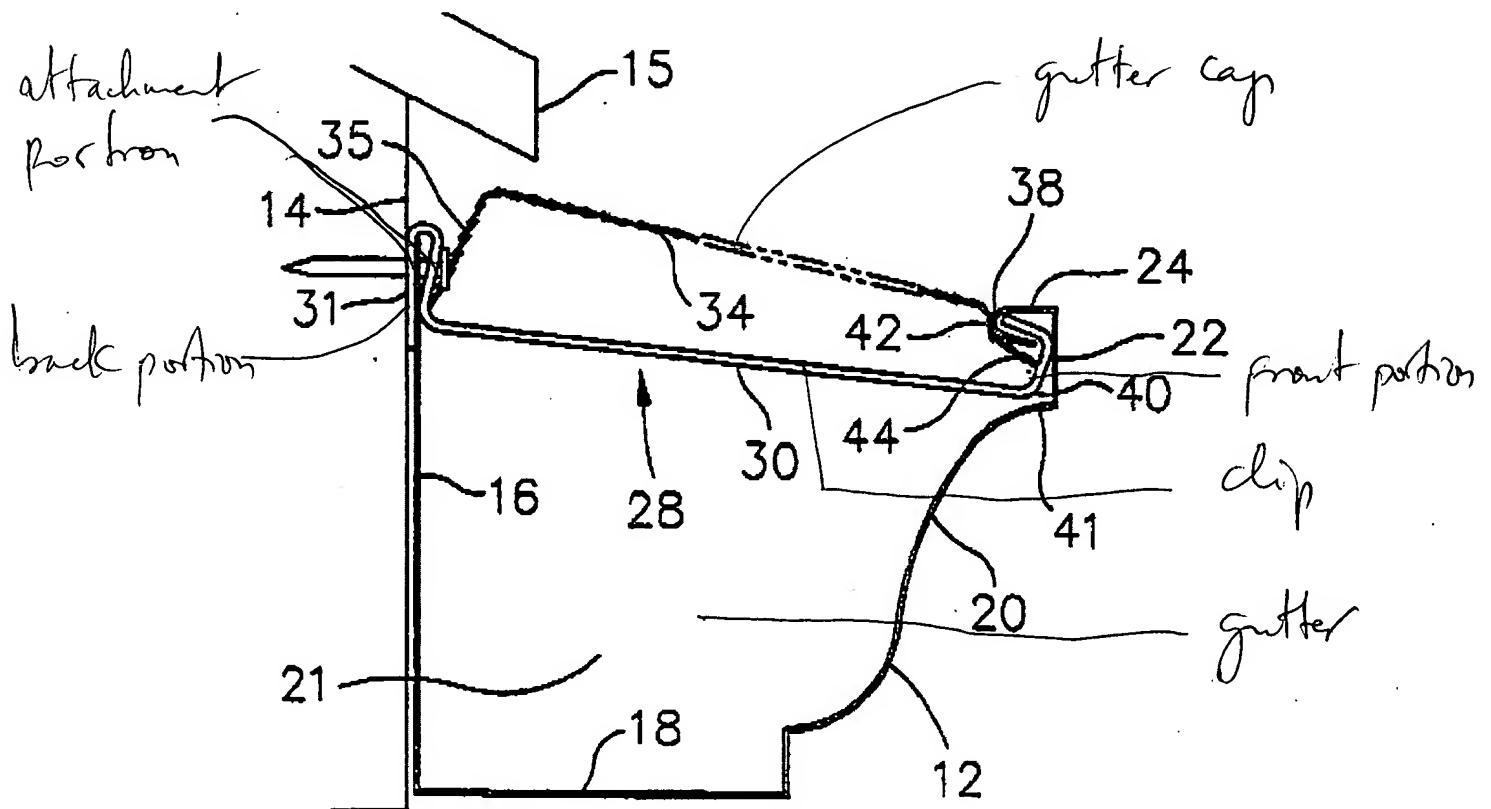
Regarding claim 2, the clip of claim 1, further comprising: a gutter attachment portion configured to receive a fastening device that is fastened to a back portion of the gutter, wherein the gutter attachment portion enables the clip to be used with gutters of different sizes.

Regarding claim 3, wherein the variable gutter attachment portion has an opening formed therein and wherein the fastening device is a screw that is screwed into

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the back portion of the gutter, and wherein an amount by which the screw is screwed into the back portion of the gutter depends at least in part on the size of the gutter.

Regarding claim 4, wherein said back portion of the clip has the shape that can be adapted to interlock with a hem edge of a gutter cap.



Response to Arguments

4. Applicant's arguments filed 05/04/05 have been fully considered but they are not persuasive.

Applicant has further amended claims 1-4 by introduced the phrase "adapted to be" into the claims and pointed to alleged differences between the prior art and his invention based upon amendment introduced into claims. However, the examiner respectfully submits that Leroney et al. clearly teaches all the limitations as claimed as pointed out in the office action. The claims are therefore still rejected as being anticipated by Leroney.

Applicant has now clearly intended to claim a clip alone by introduced the phrase "adapted to be" which made the claim broader since as the outset the claims was considered by examiner based on combination.

With regards to the phrase "adapted to be", it has been held that the recitation that an element is "adapted to" perform a function or intended use is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, Leroney et al. device is clearly capable of performing the function or intended use as claimed.

With regards to the term "variable" as argued by Applicant on page 7 is not persuasive since it is not particularly pointed out what exactly the shapes of attachment portions is going to be. Examiner, however, treats the term "variable" as broad term, which it can be interpreted as the shape can be variable. The attachment portion of Leroney et al. can be changed to a variety of shapes if so desired. Note that Figures 7 and 8 could have been restricted as two different species.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (571) 272-6818. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571) 272-6788. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
July 14, 2005.



ANITA KING
PRIMARY EXAMINER